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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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**DATE MAILED:**

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/828,022**

Applicant(s)  
**Amir M. Saffarian**

Examiner  
**Douglas X. Rodriguez**

Group Art Unit  
**2876**



☒ Responsive to communication(s) filed on Dec 16, 1998

☒ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-26 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

1. Acknowledgment is made of applicant's response filed December 16, 1998. Claims 1-26 are pending in this application.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duck U.S. Patent No. 5,440,106 (cited in PTO-892, Paper No. 4) in view of Foreman et al. U.S. Patent No. 5,377,271 (cited in PTO-892, Paper No. 6).

Duck discloses an automated system comprising a point of sale register operable to determine a transaction amount; an input device coupled to the POS register and operable to receive the transaction amount and determine check amount in response to receiving an input from a user; and a check encoder coupled to the POS register and the input device and operable to receive the check amount and encode the check amount in machine readable format (column 2, lines 40-45).

1 Duck differs from the claimed invention in that it fails to teach the printing of the  
2 information on the face of the check. Duck actually prints all of the claimed information on a  
3 separate label, which is later attached to the check itself.

4 Foreman teaches such claimed limitation. Foreman discloses an apparatus for  
5 dispensing money orders, on the face of which the amount of the money order is encoded  
6 (column 6, lines 25-47 and fig. 8).

7 To adapt Foreman's method of printing information on the face of the money order to  
8 Duck's system, would have been obvious to one of ordinary skill in the art at the time of the  
9 invention. This would have been done with the purpose of preventing counterfeiting or  
10 altering the check (column 2, lines 15-32). Although Duck's system is efficient in preventing  
11 counterfeiting since a specialized label is attached to the face of the check such that when the  
12 label is removed the check is destroyed, such system could still be altered. Foreman's  
13 method teaches how to prevent such alteration. Since the value of the check is printed directly  
14 on the face of the check, altering its value it made almost impossible. Therefore as stated  
15 above, to print the information on the face of the file instead of a separate label, would have  
16 been obvious to one of ordinary skill in the art at the time of the invention.

17 Duck also differs from the claimed invention in that it fails to teach that the check  
18 encoder is a pocket-size encoder. To modify Duck's encoder so as to make it pocket sized,  
19 would have been obvious to one of ordinary skill in the art at the time of the invention.

1 Minimizing electronic equipment is a well known process and is observed in many pieces of  
2 electronic equipment such as electronic pocket-organizers, cellular phones, fax machines, etc.  
3 All these are examples of how electronics have been minimized, with the purpose of making  
4 them more portable. Therefore to simply make the claimed encoder, pocket-sized, would  
5 have been an obvious expedient to a well known process. Furthermore, this would have been  
6 done with the purpose of making the encoder portable so as to allow a sales clerk to carry such  
7 encoder around a store in the event a customer would like to purchase an item on the spot and  
8 pay by check. Such process would reduce the long lines at the checkout aisle as well as save  
9 time when paying by check.

10 In regards to claims 2, 11, 12, 21, 22 wherein it is claimed that the check encoder  
11 comprises a magnetic ink encoder operable to encode the check amount in magnetic ink at a  
12 predetermined location on the check, is a notoriously well known and commonly used  
13 limitation. Magnetic ink, allows special codes to be printed on legal tender items such as  
14 checks, money orders and bills. Since magnetic ink is only distinguishable under special  
15 systems, its use makes counterfeiting more difficult. Furthermore, Duck discloses such  
16 limitation (column 6, lines 9-13).

17 In regards to claims 3, 4, 16, 17, 23, wherein it is claimed a keypad and a display,  
18 Duck teaches such claimed limitations (column 6, lines 22-31).

1 As for claims 5,10, 18, 26, wherein it is claimed that the check used is a blank check,  
2 such limitation is also taught by Duck (column 6, lines 16-21).

3 In regards to the remaining claims wherein it is claimed the steps of printing a payee  
4 name at a predetermined payer location on the check, printing a number in check amount as  
5 well as displaying a transaction amount all such limitations are taught by Duck (column 5,  
6 lines 1-68; column 6, lines 1-68).

7  
8 ***Response to Arguments***

9 4. Applicant's arguments filed December 16, 1998 have been fully considered but they are  
10 not persuasive. Applicant contends that Duck and Foreman do not teach or suggest all of the  
11 limitations of claim 1, including "an input device coupled to the point-of-sale register and  
12 operable to receive the transaction amount and determine a check amount in response to  
13 receiving an input from a user." Furthermore, applicant contends that the input device  
14 claimed allows the customer or retail clerk to enter in a tender amount different than the  
15 transaction amount and that such limitation is not found in Duck or Foreman. Such argument  
16 is traversed, Duck clearly states that the tender amount can be different than the transaction  
17 amount (column 8, lines 9-15).

18 In response to applicant's argument that there is no suggestion to combine the  
19 references, the examiner recognizes that obviousness can only be established by combining or

1 modifying the teachings of the prior art to produce the claimed invention where there is some  
2 teaching, suggestion, or motivation to do so found either in the references themselves or in the  
3 knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837  
4 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941  
5 (Fed. Cir. 1992). In this case, the motivation for the rejection is found in both, the references  
6 themselves, as well as in the knowledge generally available to one of ordinary skill in the art.

7  
8 *Conclusion*

9 5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time  
10 policy as set forth in 37 CFR 1.136(a).

11 A shortened statutory period for reply to this final action is set to expire THREE  
12 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO  
13 MONTHS of the mailing date of this final action and the advisory action is not mailed until  
14 after the end of the THREE-MONTH shortened statutory period, then the shortened statutory  
15 period will expire on the date the advisory action is mailed, and any extension fee pursuant to  
16 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,  
17 however, will the statutory period for reply expire later than SIX MONTHS from the mailing  
18 date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas X. Rodriguez whose telephone number is (703) 308-4081.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is (703) 308-7723.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[don.hajec@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

7. If the applicant wishes to send a fax transmission which may be intended as non-official for consideration by the examiner for interviews or other purposes, the fax should be clearly marked:




1. "DRAFT" and/or "COURTESY COPY" on the fax cover sheet along with a statement  
"DELIVER DIRECTLY TO EXAMINER", and

2.) Should be unsigned by the attorney or agent.

This will ensure that such an un-official fax transmission will not be entered into the application.

*Papers related to the application may be submitted to Group 2800 by fax transmission. Papers should be faxed to Group 2500 via the PTO Fax machine located in Crystal Plaza 4. The form of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine is: (703) 308-7722.*

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is:  
(703) 308-0956.

  
Donald Hajec  
Supervisory Patent Examiner  
Technology Center 2800

Douglas X. Rodriguez  
Patent Examiner  
GAU 2876  
February 23, 1999